

PATENT

ATTORNEY DOCKET NO. 114596-08-4015

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 09/332,263 Confirmation No.: 2707
Applicant: Michael C. Adler, et al.
Title: PROFILING PROGRAM EXECUTION BY DENSE TRACE PROFILING
AND STATISTICAL PROFILING
Filed: June 11, 1999 Art Unit: 2127
Atty Docket: 114596-08-4015 Examiner: Kenneth Tang

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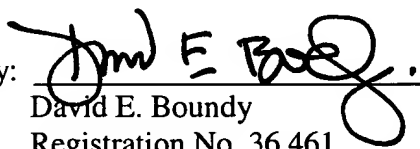
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- Petition for Extension of Time, Interview Summary and Response to Office Action
- Request for Withdrawal of Finality of Office Action
- Request to Update Palm Information

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Respectfully submitted,

WILLKIE FARR & GALLAGHER LLP

Dated: July 6, 2004

By: 
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REQUEST TO UPDATE PALM INFORMATION

Commissioner for Patents
P.O. Box 1450
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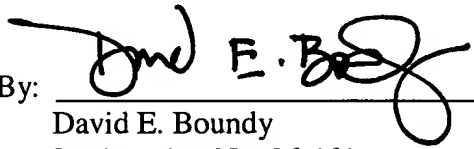
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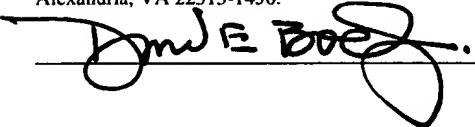
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Atty Docket: 114596-08-4015
Customer No. 38492

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AFTER FINAL – EXPEDITED PROCEDURE

REQUEST FOR WITHDRAWAL OF FINALITY OF OFFICE ACTION

Applicant observes that the Action of January 2004 was prematurely made final.

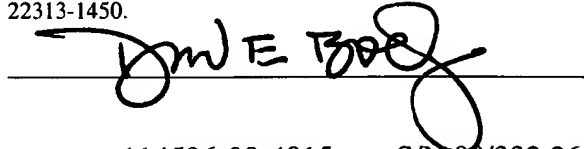
Pursuant to MPEP § 706.07(c) and (d), Applicant requests that the premature finality of the Action of January 2004 be withdrawn, and that the Response to Office Action filed herewith be entered as of right.

I. The Office Action of January 2004 Raises New Grounds of Rejection of Unamended Claims, Preventing Finality

An Action may not be made final when it introduces a new ground of rejection, where the new ground was not necessitated by an amendment. MPEP § 706.07(a).

The Office Action of June 2003 rejects claim 17 under § 102(e) over Chernoff '028 (¶ 15), and claims 7, 15 and 16 under 35 U.S.C. § 103(a) over Chernoff '028 alone (¶¶ 21, 24, 25). These claims were not amended between June 2003 and January 2004.

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Paragraph 38 of the Office Action of January 2004 concedes that no such single-reference rejection can be maintained, and that at the very least, further references must be added to support any such rejections.

The January 2004 Office Action presents new grounds of rejection that were not “necessitated by amendment.” Thus, under MPEP § 706.07(a), the Action of January 2004 is not properly made final.

II. The May Interview Establishes that Final Rejection is Premature

Applicant thanks Supervisory Examiner Meng-Ai An for two brief interviews during the weeks of May 10 and 17. It was agreed that the Chernoff '028 patent does not disclose hardware “profile circuitry” corresponding to the claims, and that at most Chernoff '028 discloses profile software. Though the issue was not explicitly discussed, the necessary consequence of this agreement is that any § 102 rejection is not sufficiently mature to “develop a clear issue for appeal.” Thus, under MPEP § 706.07, final rejection is premature.

Supervisory Examiner An indicated that she believed that the application would have to be examined further for compliance with § 103. Applicant believes that reopening prosecution for consideration of these issues is the proper course for further prosecution.

III. Conclusion

For these reasons, the finality of the Action of January 2004 should be withdrawn, prosecution should be reopened, and the accompanying Response to Office Action should be entered as of right (even without a showing of reasons under Rule 116).

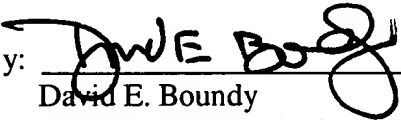
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